

REMARKS

The Office Action mailed May 27, 2004 has been reviewed and carefully considered.

The listing of pending claims appearing on pages 1, 1a and 2 of the Office Action is not correct based upon applicants' "Response To Requirement For Election Of Species/Restriction" dated May 7, 2004. According to that paper (which was filed in response to the Office Action dated March 9, 2004 which suggested various claim groupings), the following claims were pending: 47, 49-51, 53-61, 65-70, 73-81, 84, 85, 87, 90, 94, 96-110, 112-114, 121 and 127; and the remaining claims between claims 47 and 127 were withdrawn. In particular, the discrepancy relates to claims 67, 68, 72 and 79. Appropriate correction of the listing of pending claims is requested in response to this Amendment.

New claims 128 to 133 have been added. Claims 47 and 98 are the only pending independent claims. Reconsideration of the above-identified application, as amended, and in view of the following remarks is respectfully requested.

It is noted that the file does not contain a Patent Drawing Review by the Patent Office Draftsperson. It is requested that this Review be undertaken and a Review be issued in response to this Amendment.

It is noted that the file does not contain an acknowledgment of the claim for foreign priority. It is requested that such an acknowledgment be included in the response to this Amendment.

In the Office Action mailed May 27, 2004, claims 69, 70, 73, 74, 112, and 114 were objected to as being dependent upon a rejected base claim but were deemed to be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. These claims have been rewritten as new claims 128 to 133. For this reason, these new claims are allowable.

Dependent claims 59, 81, 87 and 94 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 47 has been appropriately amended so that all of these claims now overcome this rejection.

A number of pending and withdrawn claims have been amended to clarify their language.

Independent claims 47 and 98, and dependent and claims 49, 51, 53-55, 57, 58, 76, 97, 100, 102-104, 106-108, 113 and 127 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,931,143 ("Karvinen"). Dependent claim 50 was rejected under 35 U.S.C. § 103(a) as


being unpatentable over Karvinen. Dependent claims 56, 59-61, 65, 66, 77, 78, 80, 81, 84, 85, 87, 90, 94, 96, 101, 105, 109, 110 and 121 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Karvinen in view of U.S. Patent No. 5,256,257 ("Schiel").

In the Office Action (page 5), Schiel is relied upon in rejecting dependent claim 96. However, Schiel does not disclose or suggest applying to a web a web treatment substance comprising surface size or coating mix in the form of a liquid, a dispersion, an emulsion or a foam, as recited in amended independent claim 47. For this reason, amended independent claims 47 and 98 are patentable over the prior art of record. The claims dependent thereupon are patentable for the same reasons.

Applicants respectfully submit that this application is in condition for allowance, and such action is respectfully requested.

Respectfully submitted,

COHEN, PONTANI, LIEBERMAN & PAVANE

By 
Michael C. Stuart
Reg. No. 35,698
551 Fifth Avenue, Suite 1210
New York, New York 10176
(212) 687-2770

Dated: September 27, 2004